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### **REMARKS**

Claims 1-8, 13-35 and 40-63 are presently pending in this application. Claims 1, 3, 7-8, 13, 15-18, 20, 22-27, 28, 32, 34-35, 40, 42-45, 47, 49-51 and 53-54 have been amended to more particularly define the claimed invention. Claims 9-12 and 36-39 have been previously withdrawn from examination and have been canceled in this response. Claims 56-63 have been added to claim additional features of the claimed invention.

It is noted that the amendments are made only to more particularly define the invention and not for distinguishing the invention over the prior art, for narrowing the scope of the claims, or for any reason related to a statutory requirement for patentability. It is further noted that, notwithstanding any claim amendments made herein, Applicant's intent is to encompass equivalents of all claim elements, even if amended herein or later during prosecution.

Claims 1-8, 13-35 and 40-55 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Boltz, U.S. Pat. No. 6,131,024 in view of Norihisa et al., JP 05-284255.

This rejection is respectfully traversed in view of the following discussion.

#### **I. APPLICANT'S CLAIMED INVENTION**

The claimed invention (as defined, for example, by independent claim 1) is directed to an information terminal having a function of making a call, including a communicator making communication with a calling or called party, a memory storing at least one exception code, and a main control unit. The main control unit determines an item to be monitored, judges whether the item meets with a predetermined condition for prohibiting making a call, judges whether a code of a calling or called party is coincident with the exception code, and

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prohibits making a call, if the predetermined condition is satisfied, and if the code of a calling or called party is not coincident with the exception code.

Conventionally, when a total calling rate exceeds a predetermined upper limit, a calling function is entirely suppressed, and hence, it is not possible to make any calls within a predetermined period. Additionally, a user carried out resetting a calculated calling rate by performing a key operation. Accordingly, when a user forgot to reset the a calling rate, a new calling rate for a predetermined unit period was added to a calculated calling rate in a previous predetermined unit period.. On the other hand, when a calling rate is reset before a predetermined unit period passes, a calling rate having been calculated so fare in the predetermined unit period is not reflected in a total calling rate displayed in a display screen. As a result, a communication fee was displayed lower than an actual communication fee, in a display screen. (Application at page 3, line 26 to page 4 line 27).

The claimed invention (e.g., as recited in claim 1), on the other hand, includes an information terminal having a function of making a call, including a memory storing at least one exception code, and a main control unit that determines an item to be monitored, judges whether the item meets with a predetermined condition for prohibiting making a call, judges whether a code of a calling or called party is coincident with the exception code, and prohibits making a call, if the predetermined condition is satisfied, and if the code of a calling or called party is not coincident with the exception code. (Application at page 11, line 25 to page 12 line 7.)

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## II. THE ALLEGED PRIOR ART REJECTIONS

### A. 35 U.S.C. § 103(a) Rejection over Boltz, U.S. Pat. No. 6,131,024 in view of Norihisa et al., JP 05-284255

The Examiner alleges that Boltz, U.S. Pat. No. 6,131,024, (Boltz), in view of Norihisa et al., JP 05-284255, (Norihisa), teaches the invention of claims 1-8, 13-35 and 40-55.

Applicant submits, however, that Boltz in view of Norihisa does not teach or suggest each and every element and feature of the claimed invention.

The Examiner alleges that one of ordinary skill in the art would have been motivated to modify Boltz with the teaching from Norihisa to form the invention of claims 1-8, 13-35 and 40-55. Applicant submits, however that these references would not have been combined and even if combined, the combination would not teach or suggest each and every element of the claimed invention.

Applicant respectfully submits that Boltz would not have been combined with Norihisa as alleged by the Examiner. Indeed, these references are completely unrelated, (Boltz is directed to a telecommunications system that allows the owner of a mobile station to define usage limits based on air time usage or by a dollar amount, and when a limit is exceeded, the mobile station will be inoperable except for emergency calls or calls to predefined numbers established by the subscriber, and Norihisa is directed to restricting or permitting selectively required dialing to an ISD network from a telephone set after an accumulated communication charge reaches a communication charge limit) and no person of ordinary skill in the art would have considered combining these disparate references, absent impermissible hindsight.

In fact, Applicant submits that the Examiner can point to no motivation or suggestion in the references to urge the combination as alleged by the Examiner. Indeed, contrary to the

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Examiner's allegations, neither of these references teach or suggest their combination.

Therefore, Applicant respectfully submits that one of ordinary skill in the art would not have been so motivated to combine the references as alleged by the Examiner. Therefore, the Examiner has failed to make a prima facie case of obviousness.

**1. Applicant's Independent Claim 1**

Boltz fails to disclose or suggest the location of *a memory storing at least one exception code*, and there is no suggestion that the memory be in an information terminal, as recited in claim 1, or in a mobile communication device, (e.g., Mobile Station (MS) 20), as recited in dependent claim 55.

Furthermore, the control unit of Boltz that utilizes the memory is not in an information terminal or a Mobile Station. Instead, it is a Mobil Services Center (MSC) 330 remote from the Mobile Station (MS) 300 that has a "Usage Monitoring Application" 330 that checks the current usage amount and compares it with the defined usage limit. If the current usage amount exceeds the usage limit, the MSC 330 sends an error message to the MS 300 indicating excessive usage, and the call will be aborted, unless the call is an emergency call or a call to a predefined number established by the subscriber (col. 4, lines 41-53).

The MSC is not at an information terminal (claim 1) or a mobile communication device (dependent claim 55). Instead, a GSM Public Land Mobile Network, such as a cellular network 10, is composed of a plurality of areas 12, each with an MSC 14 and an integrated Visitor Location Register (VLR) 16 therein. The MSC/VLR areas 12, in turn, include a plurality of Location Areas (LA) 18, which are that part of a given MSC/VLR area

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12 in which a Mobile Station 20 may move freely without having to send update location information.

Thus, Boltz does not disclose or suggest an information terminal having a *memory storing at least one exception code*. Furthermore, as is explained above, even assuming the Mobil Services Center (MSC) 330, has a *main control unit*, it is not an information terminal.

The Office Action merely states that Boltz "does not specifically disclose that the main control unit is in the information terminal (mobile communication device)," in which Applicant concurs, but the Examiner fails to address the fact that Boltz fails to teach or suggest an *information terminal having a memory storing at least one exception code*.

Norihisa fails to teach or suggest *a memory storing at least one exception code*. The Examiner fails to identify where Norihisa teaches Applicant's memory storing at least one exception code, and Norihisa says nothing about either a memory in the telephone/ISDN terminal 1 or a code of any kind.

Furthermore, the Office Action states that Norihisa allegedly shows an information terminal in Fig. 1 comprising "controlling sections 7-11 for determining an item to be monitored, judges whether the item meets with a predetermined condition for prohibiting making a call, judges whether a code of a calling or called party is coincident with the exception code, and prohibits making a call, if the predetermined condition is satisfied, and if the code of a calling or called party is not coincident with the exception code," as allegedly shown in paragraphs [0005-0010].

However, the Examiner failed in his rejection to specifically identify what elements and language taught by Norihisa corresponds to Applicant's claim recitations of *a memory storing at least one exception code*, and *a main control unit that determines an item to be*

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*monitored, judges whether the item meets with a predetermined condition for prohibiting making a call, judges whether a code of a calling or called party is coincident with the exception code, and prohibits making a call, if the predetermined condition is satisfied, and if the code of a calling or called party is not coincident with the exception code.*

The Examiner asserts that Norihisa teaches Applicant's claims based on components including:

a telephone/ISDN terminal 1;

a registration control section 7 being outside of and remote from the telephone/ISDN terminal 1;

a phone call-charges limit registration section 8 within the telephone/ISDN terminal 1;

a registration section 9 being outside of and remote from the telephone/ISDN terminal 1;

an originating-call-control control section 10 within the telephone/ISDN terminal 1;

and

a display 11 within the telephone/ISDN terminal 1.

It is clear from the teaching of Norihisa that of the elements that the Examiner recites as comprising the *main control unit* of Applicant's invention, i.e., elements 7-11, elements 7 and 9 are outside of and remote from the telephone/ISDN terminal 1. Since Applicant's claim recitation states that an information terminal comprises a main control unit, the teaching of Norihisa teaches away from Applicant's claim recitation.

Furthermore, Norihisa fails to teach or suggest, and the Examiner fails to identify what teaching of Norihisa teaches or suggests *a main control unit*:

*that determines an item to be monitored*, Norihisa fails to teach or suggest any

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*determination of an item to be monitored;*

*that judges whether the item meets with a predetermined condition for prohibiting making a call, Norihisa fails to teach or suggest judging whether the item meets a predetermined condition since it fails to teach or suggest determining the same item to be monitored;*

*that judges whether a code of a calling or called party is coincident with the exception code, Norihisa fails to teach or suggest any code of a calling or called party whatsoever; and*

*that prohibits making a call, if the predetermined condition is satisfied, and if the code of a calling or called party is not coincident with the exception code, Norihisa fails to teach prohibition of a call based on the predetermined condition and if a code of a calling or called party is not the same as an exception code.*

Therefore, with respect to the rejection of Applicant's claim 1, Applicant respectfully submits that Norihisa would not have been combined with Boltz and even if combined, the combination would not teach or suggest each and every element of the claimed invention, since Boltz, as pointed out above, fails to teach or suggest each and every element of the claimed invention, and Norihisa fails to overcome the deficiencies of Boltz.

Applicant respectfully requests that the Examiner reconsider and withdraw this rejection with respect to independent claim 1.

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## 2. Applicant's Independent Claim 13

Independent claim 13 recites *an information terminal that prohibits making a call when a total communication fee is greater than a threshold upper limit, but allows making a call to a party or parties having been set in advance as an exception or exceptions even when a total communication fee is greater than a threshold limit.* In contrast, as was discussed above, in Boltz it is a Mobil Services Center (MSC) 330 that checks the current usage amount and compares it with the defined usage limit, and, if the current usage amount exceeds the usage limit, the MSC 330 sends an error message to the MS 300 indicating excessive usage, and the call will be aborted, unless the call is an emergency call or a call to a predefined number established by the subscriber.

Therefore, Boltz does not disclose or suggest an information terminal that prohibits making a call.

The Examiner failed to address and Norihisa fails to teach or suggest *an information terminal having a function of making a call, said information terminal prohibiting making a call when a total communication fee is greater than a threshold upper limit, but allowing making a call to a party or parties having been set in advance as an exception or exceptions even when a total communication fee is greater than a threshold upper limit.*

Applicant respectfully requests that the Examiner reconsider and withdraw this rejection with respect to independent claim 13.

## 3. Applicant's Independent Claims 17 and 24

Independent claims 17 and 24 are directed to methods of making communication an information terminal. Claim 17 recites the information terminal performs two judging steps



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and the prohibiting step. Claim 24 recites the information terminal be used to perform both of its steps. Also, claims 17 and 24 require that the call be prohibited from being made from the information terminal. There is no disclosure or suggestion in Boltz of a call being prohibited from being made from the MSC 330.

The Examiner failed to address and Norihisa fails to teach or suggest using the information terminal to judge whether said item meets with a predetermined condition for prohibiting making a call, using the information terminal to judge whether a code of a calling or called party is coincident with said exception code, and using the information terminal to prohibit making a call from the information terminal, if said predetermined condition is satisfied, and if said code of a calling or called party is not coincident with said exception code, of Applicant's claim 17.

Additionally, Examiner failed to address and Norihisa fails to teach or suggest using the information terminal to judge whether a total communication fee is greater than a threshold upper limit, and using the information terminal to prohibit making a call from the information terminal when said total communication fee is greater than said threshold upper limit, and allow making a call to a party or parties having been set in advance as an exception or exceptions even when said total communication fee is greater than said threshold upper limit, of claim 24.

Applicant respectfully requests that the Examiner reconsider and withdraw this rejection with respect to independent claims 17 and 24.

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**4. Applicant's Independent Claims 28, 40, 44 and 51**

Independent claim 28 is directed to a storage medium readable by a computer, the storage medium storing a program therein for causing a computer to act as an information terminal having a function of making a call and comprising the elements of claim 1. Accordingly, claims 28-35 are allowable for reasons analogous to those described above in connection with claims 1-8.

Independent claim 40 is directed to a storage medium readable by a computer, the storage medium storing a program therein for causing a computer to act as an information terminal having a function of making a call and further having the functions of claim 13. Accordingly, claims 40-43 are allowable for reasons analogous to those described above in connection with claim 13.

Independent claim 44 is directed to a storage medium readable by a computer, the storage medium storing a program therein for causing a computer to carry out a method of making communication by an information terminal having a function of making a call, the method comprising the steps of claim 17. Accordingly, claims 44-50 are allowable for reasons analogous to those described above in connection with claim 17.

Independent claim 51 is directed to a storage medium readable by a computer, the storage medium storing a program therein for causing a computer to carry out a method of making communication by making a call, the method comprising the steps of claim 24. Accordingly, claims 51-54 are allowable for reasons analogous to those described above in connection with claim 24.

With respect to the rejection of Applicant's claims, Applicant respectfully submits that Norihisa would not have been combined with Boltz and even if combined, the

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combination would not teach or suggest each and every element of the claimed invention, since Boltz, as pointed out above, fails to teach or suggest each and every element of the claimed invention, and Norihisa fails to overcome the deficiencies of Boltz.

Therefore, the Examiner is respectfully requested reconsider and withdraw these rejections.

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### III. FORMAL MATTERS AND CONCLUSION

Applicant request that the Examiner acknowledge receipt of the priority document filed on October 10, 2000.

In view of the foregoing, Applicant submits that claims 1-8, 13-35 and 40-63, the claims presently pending in the application, are patentably distinct over the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.


Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

The Commissioner is hereby authorized to charge any deficiency in fees or to credit any overpayment in fees to Attorney's Deposit Account No. 50-0481.

Date:

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Respectfully Submitted,



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